

09 FEB 2009



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON DC 20001-4413

In re Application of	:	
MONTELIUS et al.	:	
Application No.: 10/576,499	:	DECISION
PCT No.: PCT/EP2004/052656	:	
Int. Filing Date: 25 October 2004	:	
Priority Date: 24 October 2003	:	
Attorney's Docket No.: 023860103	:	
For: APPARATUS AND METHOD FOR	:	
ALIGNING SURFACES	:	

This decision is in response to applicants' "PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 C.F.R. 1.137(a)", which has properly been treated as a petition under 37 CFR 1.181, filed in the United States Patent and Trademark Office (USPTO) on 09 December 2008.

**BACKGROUND**

On 25 October 2004, applicants filed international application PCT/EP2004/052656, which designated the United States and claimed a priority date of 24 October 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 06 May 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 April 2006.

On 20 April 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 19 December 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 24 June 2008, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to timely respond to the Notification mailed 19 December 2006.

On 09 December 2008, applicants filed the instant submission, which has properly been treated as a petition under 37 CFR 1.181.

### DISCUSSION

#### Petition Under 37 CFR 1.181

If applicants can establish nonreceipt of the NOTIFICATION OF MISSING REQUIREMENTS, then the application was never abandoned. In such case, the holding of abandonment will be withdrawn pursuant to 37 CFR 1.181. See MPEP § 711.03(c), para. I.A. The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) and (2) have been met. As to item (3), MPEP § 711.03(c), para. I.A. states that a "copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action." Such a docket record has been provided. Thus, item (3) has been met as well.

#### Declaration of Inventors

The declaration filed 09 December 2008 is an improper composite declaration, consisting of one "Page 1 of 3", two "Page 2 of 3", and one "Page 3 of 3". Each inventor must be presented with a complete declaration which lists all of the inventors, and the signature of each inventor must appear on at least one complete declaration. Multiple complete declarations may be submitted, but it is not permissible to combine pages of separate documents.

Further, the declaration filed 09 December 2008 is not sufficient because it contains non-initialed alterations (the address and residence of Marc Beck and the address of Patrick Carlberg). 37 CFR 1.52(c). "The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration." MPEP § 605.04(a). Item I.

### CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The NOTIFICATION OF MISSING REQUIREMENTS mailed 19 December 2006 is VACATED.

For the reasons set forth above, the NOTIFICATION OF ABANDONMENT mailed 24 June 2008 is VACATED.

Applicants are required to file a proper declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301  
Facsimile: (571) 273-0459